

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAIME NAVARRETE

Appeal 2006-2524
Application 10/664,147
Technology Center 1700

Decided: October 27, 2006

Before PAK, WALTZ, and JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's refusal to allow claims 1 through 7 and 9, as amended subsequent to the Final Rejection (see the Amendment dated July 25, 2005, entered as per the Advisory Action dated Aug. 4, 2005; Br. 3). Claims 10-14 are the only other claims pending in this application and stand withdrawn from consideration as directed to a

non-elected invention (Br. 3). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to Appellant, the invention is directed to a battery separator which comprises a microporous membrane including an ultra high molecular weight polyethylene, a filler, and a grass lignin (Br. 4). Independent claim 1 is illustrative of the invention and is reproduced below:

1. A battery separator comprising:
a microporous membrane including
an ultra high molecular weight polyethylene,
a filler, and
a grass lignin.

The Examiner has relied on Navarrete, WO 02/28955 A2, an International Application published on Apr. 11, 2002, as the sole evidence of unpatentability (Answer 2). Appellant relies on five references cited in the Evidence Appendix attached to the Brief as evidence of patentability (Br. 13).

Claims 1-7, and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Navarrete (Answer 2).¹ Based on the totality of the record,

¹ The rejection of claims 4 and 9 under 35 U.S.C. § 112, first paragraph, was withdrawn in view of the amendment dated July 25, 2005 (see the Advisory Action dated Aug. 4, 2005). Contrary to the Brief (pages 3-4), the withdrawn rejection was based on paragraph one, not paragraph two, of Section 112, and did not involve claims 21-26, but only claims 4 and 9. We note that claims 4 and 9, as now amended, lack antecedent basis in claims 1 and 6, respectively, for the term “grass lignin source.” In the event of further or continuing prosecution, this issue should be addressed by the Examiner and Appellant.

we AFFIRM this rejection on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

The Examiner finds that Navarrete discloses a lead acid battery separator comprising a microporous membrane including an ultra-high molecular weight polyethylene (UHMWPE), a filler, processing oil and a lignin (Answer 2-3). The Examiner further finds that Navarrete discloses grass lignins, as well as the reduction of antimony poisoning by use of the UHMWPE separator (Answer 4). Thus, the Examiner finds that the claims are anticipated (*id.*).

Appellant argues that the compound disclosed in Navarrete is “wood lignins,” which is not the same as the “grass lignins” as claimed (Br. 7). Appellant argues that Navarrete, at page 8, ll. 16-17, teaches that “[l]ignins refers to those by-products of wood pulping operations” and there is no mention or suggestion to use any other type of lignins (*id.*). Appellant submits that the “only real question” before the Board is whether Navarrete teaches the use of grass lignins (Reply Br. 6).²

Anticipation is a question of fact. *See In re Paulsen*, 30 F.3d 1475, 1478, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). We agree with the Examiner’s finding (Answer 3) that Navarrete discloses a “lignin” generally

² We note that Appellant submits that the “only question” before the Board is if the feature of grass lignins as claimed differentiates the invention from the wood lignins “clearly taught” by Navarrete (Br. 14). Although this “question” differs from the “question” posed by the Reply Brief, we believe that both questions are answered in our Opinion *infra*. We refer to and cite from the “Amended Reply Brief” dated Feb. 8, 2006.

as a component of the battery separator (see Navarrete, Abstract; 3, ll. 1-3; 4, ll. 4-7, 11-13, and 20-22; 5, ll. 3-5, and claim 1). We determine that Navarrete at pages 1-2 teaches three sources of “lignin,” each with a slightly different chemical composition, and these lignins are identified as grass lignins, softwood lignins, and hardwood lignins. We note, as does Appellant (Br. 8), that Navarrete teaches these three types of lignins under the heading “Background of the Invention.” Thus, we determine that this teaching at pages 1-2 of the reference applies toward *the invention* of Navarrete which is the use of “lignins” in general as a component in thermoplastics, specifically battery separators (e.g., see the Abstract or page 4, ll. 4-7). Although we agree with Appellant (Br. 7-8; Reply Br. 6) that Navarrete teaches that “[l]ignins include softwood lignins, hardwood lignins, and mixtures thereof” and that “[h]ardwood lignins are preferred,” we also note that Appellant correctly states that these teachings from the reference are under the “Detailed Description of the Invention.” We do not agree with Appellant’s argument that Navarrete has limited the invention to his “Detailed Description of the Invention.”

In view of the findings discussed above, we further find that Navarrete teaches “lignins” as encompassing a genus of three types, with specific disclosure and embodiments of two types of these lignins (hardwood and softwood). We determine that one skilled in this art would, on reading the Navarrete disclosure, at once envisage each member of this limited class, and thus this reference disclosure is sufficient to put the public in possession of the invention as claimed. *See In re Petering*, 301 F.2d 676, 681-82, 133 USPQ 275, 280 (C.C.P.A. 1962); *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (C.C.P.A. 1972); *In re Schaumann*, 572 F.2d 312, 315-

17, 197 USPQ 5, 9 (C.C.P.A. 1978); and *In re Sivaramakrishnan*, 673 F.2d 1383, 1384, 213 USPQ 441, 442 (C.C.P.A. 1982). Accordingly, we AFFIRM the Examiner's rejection of claims 1-7 and 9 under 35 U.S.C. § 102(b) as anticipated by Navarrete. We additionally note that the evidence submitted by Appellant with the Brief allegedly shows that lignins from a grass source are structurally different from lignins derived from a wood source (Br. 13). This issue is not relevant to our decision as discussed above.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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